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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,084	06/08/2000	Yoshikazu Kobayashi	071671/0153	9809
22428	7590	11/24/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			LAFORGIA, CHRISTIAN A	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/589,084	KOBAYASHI, YOSHIKAZU	
	Examiner	Art Unit	
	Christian La Forgia	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 August 2004 has been entered.

2. Claims 1-18 have been presented for examination.

Response to Arguments

3. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

4. See further rejections that follow.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-4, 6-12, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,222,859 to Yoshikawa, hereinafter Yoshikawa, in view of U.S. Patent No. 6,430,178 to Yahiro, hereinafter Yahiro.

7. As per claim 1, Yoshikawa teaches a telephone communication system comprising:
a public network (Figure 3 [block 4]; column 2, lines 57-65; column 5, lines 55-59),
a specific ISP network (Figures 2, 3; column 2, lines 18-23; column 5, lines 47-51), and

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a plurality of telephone sets accommodated in the public network (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-10),

wherein when a calling telephone set, which is a subscriber to the specific ISP network provides connection point data specific to said specific ISP network for making internet service telephone communication to a called telephone set, said connection point data provided using the public network, the called telephone set receiving the connection point data from the public network and connecting itself to the specific ISP network according to the connection point data, and the calling telephone set connecting itself to the specific ISP network (column 7, lines 25-42; column 11, lines 28-40).

8. Yoshikawa does not disclose wherein said called and calling parties are connected for making said internet service telephone communication using the same specific ISP network.

9. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the called and calling parties to be connected using the same specific ISP network, since Yahiro states at column 1, lines 27-45 that such a modification would allow for a smoother transmission of data.

10. As per claim 2, Yoshikawa teaches a telephone communication system comprising:
a public network (Figure 3 [block 4]; column 2, lines 57-65; column 5, lines 55-59),
a specific ISP network (Figures 2, 3; column 2, lines 18-23; column 5, lines 47-51), and

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a plurality of telephone sets accommodated in the public network (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-10),

wherein when a calling telephone set, which is a subscriber to the specific ISP network provides connection point data specific to said specific ISP network for making internet service telephone communication to a called telephone set, said connection point data provided using the public network, the called telephone set receiving the connection point data from the public network and connecting itself to the specific ISP network according to the connection point data, and the calling telephone set connecting itself to the specific ISP network (column 7, lines 25-42; column 11, lines 28-40),

the connection point data including at least an IP address in the specific ISP network and a telephone number of a point to be connected to the specific ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40).

11. Yoshikawa does not disclose wherein said called and calling parties are connected for making said internet service telephone communication using the same specific ISP network.

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the called and calling parties to be connected using the same specific ISP network, since Yahiro states at column 1, lines 27-45 that such a modification would allow for a smoother transmission of data.

13. As per claim 3, Yoshikawa teaches a telephone communication system comprising:
a public network (Figure 3 [block 4]; column 2, lines 57-65; column 5, lines 55-59),

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a specific ISP network (Figures 2, 3; column 2, lines 18-23; column 5, lines 47-51), and a plurality of telephone sets accommodated in the public network (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-10),

wherein when a calling telephone set, which is a subscriber to the specific ISP network provides connection point data specific to said specific ISP network for making internet service telephone communication to a called telephone set, said connection point data provided using the public network, the called telephone set receiving the connection point data from the public network and connecting itself to the specific ISP network according to the connection point data, and the calling telephone set connecting itself to the specific ISP network (column 7, lines 25-42; column 11, lines 28-40),

the connection point data including at least an IP address in the specific ISP network and the telephone number of a point to be connected to the specific ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40).

14. Yoshikawa does not teach a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function of sending out a call from each telephone set. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a push-button telephone since the Examiner takes Official Notice of the equivalence of computer terminals for their use in the phone calling art and the selection of any of these known equivalents to a computer terminal with phone calling capabilities would be within the level of ordinary skill in the art.

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15. Yoshikawa does not disclose wherein said called and calling parties are connected for making said internet service telephone communication using the same specific ISP network.

16. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the called and calling parties to be connected using the same specific ISP network, since Yahiro states at column 1, lines 27-45 that such a modification would allow for a smoother transmission of data.

17. Regarding claims 4, 11, and 12, Yoshikawa teaches wherein functions of each telephone set are executed on a personal computer (Figure 4; column 6, lines 5-65).

18. Regarding claims 6, 15 and 16, Yoshikawa teaches:

a ten-key unit having dial keys and a function key for indicating an internet telephone service (Figure 4 [block 14]; column 6, lines 20-42);

a display unit for displaying a call arrival notification and results of various processes in the telephone set (Figure 4 [block 15]; column 6, lines 32-42);

an accumulating unit for storing telephone number data and access identifier data of internet connection points to be connected by the calling and called sides (column 8, lines 31-48; column 9, lines 51-67; column 11, lines 27-40; column 13, lines 15-38);

a voice codec to be started by a command for voice communication in the specific ISP network (Figure 4 [block 18]; column 6, lines 52-55);

a telephone set control unit for detecting depressed push-buttons in the ten-key unit, obtaining the connection point data from the accumulating unit, sending out dial data and

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connection point data via the public network, starting the voice codec when the dialed side has been connected to the specific ISP network and, upon arrival of a call, retrieving the connection point data of the calling side, effecting connection to the specific ISP network by retrieving and referring to the accumulating unit according to the connection point data and informing the calling side of the connection (Figures 1, 2 [blocks T151-T153], 3 [blocks 1, 2], 4; column 2, lines 22-28; column 5, lines 47-51; column 6, lines 5-10).

19. Regarding claims 7, 17, and 18, Yoshikawa teaches wherein each telephone set further comprises an encryption unit for permitting exchange of connection point data in terms of ciphers (column 8, lines 31-48).

20. As per claim 8, Yoshikawa teaches an Internet communication method comprising steps of:

providing, by a calling telephone set that is a subscriber to a specific ISP network, of connection point data, specific to said specific ISP, for making internet service telephone communication to a called telephone set, said connection point data being transmitted using a public network (column 7, lines 25-58; column 11, lines 28-50),

the called telephone set receiving the connection point data and connecting to the specific ISP network on the basis of the connection point data (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40), and

the calling telephone set connecting to the specific ISP network (column 7, lines 51-58).

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21. Yoshikawa does not disclose wherein said called and calling parties are connected for making said internet service telephone communication using the same specific ISP network.

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the called and calling parties to be connected using the same specific ISP network, since Yahiro states at column 1, lines 27-45 that such a modification would allow for a smoother transmission of data.

23. As per claim 9, Yoshikawa teaches an Internet communication method comprising steps of:

providing, by a calling telephone set that is a subscriber to a specific ISP network, of connection point data for making internet service telephone communication to a called telephone set, said connection point data being specific to said specific ISP and being transmitted using a public network (column 7, lines 25-58; column 11, lines 28-50),

the called telephone set receiving the connection point data from the public network and connecting to the specific ISP network on the basis of the connection point data (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40), and

the calling telephone set connects itself to the specific ISP network (column 7, lines 51-58),

the connection point data including at least an IP address in the specific ISP network and a telephone number of a point to be connected to the specific ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40).

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24. Yoshikawa does not disclose wherein said called and calling parties are connected for making said internet service telephone communication using the same specific ISP network.

25. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the called and calling parties to be connected using the same specific ISP network, since Yahiro states at column 1, lines 27-45 that such a modification would allow for a smoother transmission of data.

26. As per claim 10, Yoshikawa teaches an Internet communication method comprising steps of:

providing, by a calling telephone set that is a subscriber to a specific ISP network, of connection point data for making internet service telephone communication to a called telephone set, said connection point data being specific to said specific ISP and being transmitted using a public network (column 7, lines 25-58; column 11, lines 28-50),

the called telephone set receiving the connection point data from the public network and connecting to the specific ISP network on the basis of the connection point data (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40), and

the calling telephone set connecting to the specific ISP network (column 7, lines 51-58),
the connection point data including at least an IP address in the specific ISP network and a telephone number of a point to be connected to the specific ISP network (column 5, lines 60-67; column 7, lines 25-42; column 11, lines 28-40).

27. Yoshikawa does not teach a push-button telephone set having various function keys being provided between each of the plurality of telephone sets and the public network with a function

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of sending out a call from each telephone set. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a push-button telephone since the Examiner takes Official Notice of the equivalence of computer terminals for their use in the phone calling art and the selection of any of these known equivalents to a computer terminal with phone calling capabilities would be within the level of ordinary skill in the art.

28. Yoshikawa does not disclose wherein said called and calling parties are connected for making said internet service telephone communication using the same specific ISP network.

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the called and calling parties to be connected using the same specific ISP network, since Yahiro states at column 1, lines 27-45 that such a modification would allow for a smoother transmission of data.

30. Claims 5, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshikawa and Yahiro as applied to claim 1 above, and further in view of U.S. Patent No. 6,690,654 to Elliott et al., hereinafter Elliott.

31. Regarding claims 5, 13, and 14, Yoshikawa and Yahiro do not teach wherein functions of each telephone set are executed with an IVR (interactive voice response) unit or a facsimile data server or a voice recognition dialer or a voice mail.

32. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the telephone functions executed with an IVR or a facsimile data server or a voice recognition dialer or a voice mail (Elliott: column 4, lines 48-65), since Elliott states at

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column 1, lines 41-48 that such a modification would allow communicating parties to exchange information in a conference setting.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

34. The following patents are cited to further show the state of the art with respect to internet telephony, such as:

United States Patent No. 6,078,579 to Weingarten, which is cited to show an internet telephony system.

United States Patent No. 6,137,792 to Jonas et al., which is cited to show routing and transmitting data packets over a bypass circuit-switched computer network.

United States Patent No. 6,628,617 B1 to Karol et al., which is cited to show internetworking traffic on connectionless and connection-oriented networks.

United States Patent No. 6,819,663 B2 to Komuro, which is cited to show internet telephone system, especially calls taking place on individual network providers, see Figures 17, 19 and 23.

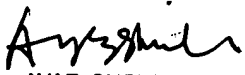
35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

36. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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37. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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